

REMARKS

In the Office Action dated July 22, 2003, Claims 8-15 were rejected under 35 U.S.C. §112, second paragraph as being indefinite. A lack of antecedent basis for two phrases in Claim 8 was noted, and has been corrected.

With regard to Claims 9 and 10 the examiner stated the redundancy of the trigger requirement being sensitivity or enabled and it renders those claims indefinite. The examiner stated the concept of a value being designated as a trigger means that the trigger must be sensitive at the trigger point. This portion of the rejection under Section 112, second paragraph is respectfully traversed.

First, it is noted that method claims 2 and 3 track apparatus claims 9 and 10, but were not rejected under Section 112, second paragraph. Nevertheless, Applicant submits the Examiner is applying an unjustifiably restrictive definition of a "trigger" and rejecting Claims 9 and 10 under Section 112, second paragraph. A circumstance which produces a trigger signal in an electronic circuit need not necessarily be a trigger point simply being reached, or a trigger level being exceeded. A trigger condition or trigger requirement may be the fulfillment of a number of occurrences, such as in the manner of an AND GATE. Multiple conditions may have to be fulfilled, or multiple occurrences may have to occur, before a trigger signal is generated.

Therefore, Claim 9 refers to the trigger requirement as being sensitivity, which is the simply "yes" or "no" trigger requirement. Claim 10 refers to enablement, which encompasses the possibility of multiple events having to be satisfied in order for the trigger signal to be generated. In fact, this is explicitly set forth in Claim 10, which states that triggering occurs only when the second respiration indicator signal

indicates commencement of a natural change of respiratory phase. One or more other conditions, which would be suitable for causing the triggering to occur, may exist, but if the second respirator indicator signal does not indicate commencement of a natural change of respiratory phase, triggering will not be enabled. Triggering will only be enabled when, among other things, the second respiration indicator signal indicates commencement of a natural change of respiratory phase.

All of Claims 8-15, therefore, are submitted to be in compliance with Section 112, second paragraph.

Claims 1-4 and 7-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ward et al. Claims 5, 6 and 13-15 were stated to be rejected under 35 U.S.C. §103(a) as being unpatentable over Sinderby, however, applicant assumes the Examiner intended that rejection to be based on Ward in view of Sinderby, in view of the comments in paragraph 7 of the Office Action.

These rejections based on the prior art are respectfully traversed for the following reasons:

In paragraph 6 of the Office Action, the Examiner has acknowledged a number of elements of independent claims 1 and 8 which are not explicitly disclosed in the Ward et al reference. The Examiner stated that "one of ordinary skill appreciating that the control unit being a programmable based system all of the functions disclosed are indicative of various aspects of its program, i.e. algorithms and thus serving as the basis of obvious equivalency of structure since they are the same functions and capabilities as set forth by applicant." As best as Applicant can understand this statement, the Examiner believes that only routine re-programming of the processor disclosed in the Ward et al reference would be necessary in order

for the Ward et al reference to perform the method of Claim 1 or have the structure and components of Claim 8.

Applicant respectfully submits this is no more than an "obvious to try" rejection or a rejection concluding the obviousness automatically follows from noting the capabilities of those of ordinary skill in the art. Section 103, however, requires much more. In order to substantiate an obviousness rejection the Examiner must identify some motivation, inducement or teaching in the prior art that is relied upon in order to cause a person of ordinary skill in the art to modify the prior art to arrive at the claimed subject matter. The Examiner has not identified any such teaching, motivation or inducement in the Ward et al reference. The Examiner has suggested that data entered by a physician can be considered as a triggering requirement in the Ward et al reference, which, according to the Examiner, could then be modified on the basis of a detection of a certain circumstances or events. Applicant submits that in the context of the Ward et al reference, a physician would be astonished to learn that the requirements for operating the Ward device, that were presumably carefully selected and entered by the physician, could be altered without any input or decision-making on the part of the physician. Certainly the Examiner has not identified any teaching, motivation or inducement associated with the Ward apparatus which would indicate to a physician that it would be desirable to depart from the entered settings, and therefore a person of ordinary skill in the art, without having the benefit of reading the present disclosure, would more likely be inclined to preserve the settings entered by a physician, rather than to depart therefrom.

Moreover, selecting the circumstances under which the settings can be departed from, and which changes in the operation of the apparatus will occur as a

result of those deviations, involve significant invented input, and such details are nowhere suggested in the Ward et al reference.

The Examiner's rejection is basically a recognition, with which applicant does not disagree, that almost any robust computer or processor can be programmed in many different ways. Simply having knowledge of this basic fact of computer technology, however, provides no instruction or inducement to modify a particular processor in a particular way. The provisions of 35 U.S.C. §103 require more than simply a recognition of the capabilities of those of ordinary skill in the art, but require identification of explicit teachings in the prior art references relied upon by the Examiner as evidence to substantiate and obviate rejection. Application respectfully submits the Examiner has failed to provide such evidence, and therefore the rejections based on Ward et al, alone or in combination with Sinderby, are no more than conjecture about programming possibilities.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,



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